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*Walter L. Felt*  
Attorney for Applicant(s)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/027,714 Confirmation No.: 6090  
Applicant : David M. Austin et al.  
Title : DETECTION OF OBSERVERS AND  
COUNTERMEASURES AGAINST OBSERVERS  
Filed : December 21, 2001  
TC/A.U. : 2134  
Examiner : Christopher J. Brown  
Docket No. : AUZ-002 P

Mail Stop Petition  
Commissioner for Patents  
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**REQUEST TO WITHDRAW ABANDONMENT/PETITION TO REVIVE BASED ON  
UNITED STATES PATENT AND TRADEMARK OFFICE ERROR**

Dear Sir:

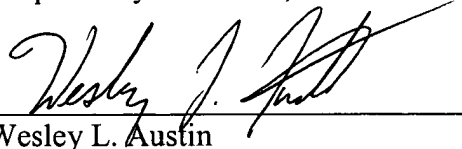
In response to the Notice of Abandonment mailed on October 6, 2008, Applicants respectfully submit that the Notice was incorrectly issued and the application should not have been abandoned. Applicants hereby request that the application be revived due to an error made by the United States Patent and Trademark Office.

The Applicants filed an Appeal Brief on September 5, 2006. A Decision on Appeal was received by the Applicants from the Board of Patent Appeals and Interferences, mailed July 29, 2008, indicating that the examiners rejection was affirmed. Applicants then filed a Request for Continued Examination and Response with a Certificate of Mailing dated September 26, 2008. Therefore, the application should not have been abandoned because the Response to Office Action was filed within the 60 day period in which to reply after a Decision from the Board of

Patent Appeals and Interferences. Accordingly, Applicants respectfully request that the Notice of Abandonment be withdrawn and prosecution of the application resume.

Enclosed is a copy of the Decision from the Board of Patent Appeals and Interferences, Applicants' Request for Continued Examination and the stamped Post Card returned to the Applicants from the United States Patent & Trademark Office indicated that the Response was received by the USPTO on September 30, 2008.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin", is written over a horizontal line.

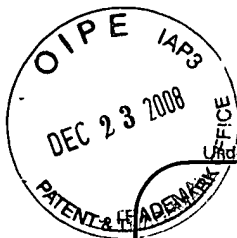
Wesley L. Austin

Reg. No. 42,273

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Date: December 18, 2008

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**Request  
for  
Continued Examination (RCE)  
Transmittal**Address to:  
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P.O. Box 1450  
Alexandria, VA 22313-1450

Application Number	10/027,714
Filing Date	December 21, 2001
First Named Inventor	David M. Austin
Art Unit	2134
Examiner Name	Thomas M. Szymanski
Attorney Docket Number	AUZ-002 P

**This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.**  
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).
- a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- ii. ☐ Other \_\_\_\_\_
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- iii. ☐ Information Disclosure Statement (IDS)
- ii. ☐ Affidavit(s)/ Declaration(s)
- iv. ☐ Other \_\_\_\_\_
2. **Miscellaneous**
- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other \_\_\_\_\_
3. **Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.  
The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. \_\_\_\_\_
- a. ☐ RCE fee required under 37 CFR 1.17(e)
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☐ Other \_\_\_\_\_
- b. ☒ Check in the amount of \$ 405.00 enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.****SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

Signature	<i>Wesley L. Austin</i>	Date	September 26, 2008
Name (Print/Type)	Wesley L. Austin	Registration No.	42,273

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Signature	<i>Wesley L. Austin</i>	Date	September 26, 2008
Name (Print/Type)	Wesley L. Austin		

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

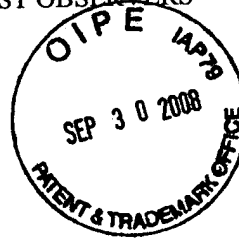
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TO THE UNITED STATES PATENT AND TRADEMARK  
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SUBMITTED: Response to April 7, 2006 Office Action, Request  
for Continued Examination, Check #147 in the  
amount of \$405.

Inventor(s):	David M. Austin et al.
Title:	DETECTION OF OBSERVERS AND COUNTERMEASURES AGAINST OBSERVERS
Serial No.:	10/027,714
Filing Date:	December 21, 2001
Mailed:	September 26, 2008
Docket:	AUZ-002 P





# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,714	12/21/2001	David M. Austin	AUZ-002 P	6090

7590  
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Bountiful, UT 84010

07/29/2008



EXAMINER
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BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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2134

MAIL DATE	DELIVERY MODE
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07/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID M. AUSTIN and WESLEY L. AUSTIN

Appeal 2007-0577  
Application 10/027,714<sup>1</sup>  
Technology Center 2100

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Decided: July 28, 2008

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Before JAMES D. THOMAS, JEAN R. HOMERE, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 21. Claims 22 through 34 have been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

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<sup>1</sup> Filed on Dec. 21, 2001. The real party in interest is Trapware Corp.

Appellants invented a method and system for scanning a computer to detect therein the presence of observer programs that monitor and record a user's activities on the computer. (Spec. 4.) As depicted in Figure 2, an observer program (34) gathers data from various activities (36, 38, 42) occurring on a computer (20) and stores the collected data in a log file (44). (Spec. 12.) As shown in Figure 3, an observer detector (50) is installed on the computer to detect the presence of such observer programs by comparing before and after image contents of the computer memory (24) at a predetermined time. (Spec. 13-15.)

Independent claim 1 further illustrates the invention.. It reads as follows:

1. A computer program embodied in a computer-readable medium for scanning a computer for observer programs, the computer program comprising:

observer data comprising a plurality of observer program characteristics descriptive of a plurality of observer programs where the observer programs are programmed to observe activities on a computer system and to create log data;

reading instructions that read memory of the computer to obtain memory data;

comparing instructions that compare the plurality of observer program characteristics with memory data characteristics to determine whether an observer program is present on the computer;

generating instructions that generate results from the comparing, wherein the results generated indicate whether the observer program is present on the computer; and

outputting instructions that provide the results through a graphical user interface.

The Examiner relies on the following prior art:

Drake	US 6,006,328 B1	Dec. 21, 1999
Togawa	US 6,240,530 B1	May 29, 2001

The Examiner rejects the claims on appeal as follows:

Claims 1 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Togawa and Drake.

#### FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

##### *Togawa*

1. Togawa discloses a method and system for detecting and exterminating viruses on a computer. Particularly, Togawa discloses a virus extermination program installed on the computer memory to detect, identify and destroy certain types of viruses on the computer. (Col. 4, ll. 1-22.)



2. After detecting characteristics in memory indicating the presence of a virus, the extermination program identifies the name and type of the virus to subsequently destroy it. (Col. 5, ll. 9-18; col. 8, ll. 22-30.)

*Drake*

3. Drake discloses a method and system that uses an anti-spy computer code to detect rogue software programs that eavesdrop, attack or steal ID-data on the computer. The anti-spy code continuously scans the computer memory by comparing its memory image data with known characteristics data to detect hot patching. (Col. 3, ll. 38-44; col. 6, ll. 10-20.)

PRINCIPLES OF LAW

OBVIOUSNESS

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

*KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) wherein evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-40 (2007)). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR*, 127 S. Ct. at 1742.

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the

art. *KSR*, 127 S. Ct. at 1740-41. *See also Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2007).

### ANALYSIS

Independent claim 1 recites in relevant part detecting the presence of observer programs that observe activities on a computer system to create a log of data by comparing observer program characteristics with memory data characteristics. (Claims Appendix.) Appellants argue that the combination of Togawa and Drake does not teach these limitations. (App. Br. 6-9.) Particularly, Appellants argue that the combination of Togawa and Drake teaches detecting the presence of virus programs on the computer, and not observer programs. (*Id.*)

In response, the Examiner avers that Togawa's disclosure of detecting and identifying the characteristics of virus programs on a computer, taken in combination with Drake's disclosure of using anti-spy techniques to detect unauthorized spying software programs on the computer, teaches the cited limitations. (Ans. 8-11.)

Therefore, the pivotal issue before us is whether one of ordinary skill in the art would have found that Togawa's virus detection mechanism combined with Drake's use of anti-spy techniques to detect the presence of a rogue software on a computer teaches the limitations in question, as recited in independent claim 1. We answer this inquiry in the affirmative.

As set forth in the Findings of Fact section, Togawa teaches running a virus check on a computer to detect the presence of virus characteristics thereon, and to identify the types of viruses corresponding thereto. (FF 1-2.) Further, Drake teaches scanning a computer memory by running therein an anti-spy software, which compares before memory scan images with after memory scan images to detect the presence of a rogue software thereon. (FF. 3.) One of ordinary skill in the art would readily recognize that the detection of viruses in a computer memory, as taught by Togawa, routinely involves comparing known virus characteristics with data in the computer memory to identify similar data patterns. Further, the ordinarily skilled artisan would recognize that Drake's use of anti-spy software explicitly involves a comparison between known characteristics data with memory data to identify similar data patterns indicating the presence of rogue software in the computer. The ordinarily skilled artisan would therefore conclude that the proffered combination would *predictably result* in running anti-spyware program on a computer to scan the memory for certain spy characteristics in order to detect the presence of rogue software programs thereon.

Additionally, we note that Appellants' arguments regarding the informational content of the compared characteristics data are not persuasive. Nowhere in the cited claim is there an indication that the nature of the compared data and the content thereof are being used to functionally achieve something other than merely detecting the presence of a

corresponding software. We are satisfied that both the claimed invention and the Togawa-Drake combination are directed to comparing known characteristics data with data in the computer memory for the same purpose of detecting the presence of a corresponding software. Thus, whether the characteristics data indicate to an observer program or a virus/rogue program, the nature of the data being compared here is of little importance. In either case, the computer memory is scanned by comparing characteristics data to detect the presence of a corresponding software. Consequently, the informational content of program characteristics is nonfunctional descriptive material, which is entitled to no patentable weight. *See Manual of Patent Examining Procedure* (MPEP) § 2106.01 (8th ed., Rev. 5, Aug. 2006).

When “non-functional descriptive material” is recorded or stored in a memory or other medium (i.e., substrate), it is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the substrate and is given no patentable weight. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (“Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight.”). *See also Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1003; affirmed without written opinion Jun. 12, 2006). The Examiner need not give patentable weight to descriptive material absent a new and

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Application 10/027,714

unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; affirmed without written opinion Aug. 17, 2006).

It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Togawa and Drake renders independent claim 1 unpatentable.

Appellants do not provide separate arguments with respect to the rejection of dependent claims 2 through 21. Consequently, these claims fall together with independent claims 2 through 21. 37 C.F.R. § 41.37(c)(1)(vii).

#### CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in concluding that claims 1 through 21 are unpatentable over the combination of Togawa and Drake under 35 U.S.C. § 103.

#### DECISION

We affirm the Examiner's decision rejecting claims 1 through 21.

Appeal 2008-0577  
Application 10/027,714

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

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